

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Attorney Docket No. 13315US02

In the Application of: MacInnis)	Electronically Filed
)	
U.S. Serial No.: 10/034,414)	
)	
Filed: December 27, 2001)	
)	
Examiner: Phillippe, Gims)	
)	
Group Art Unit: 2621)	
)	
Confirmation: 1160)	
)	

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

This is an appeal from the Office Action made Final mailed January 20, 2010. A Notice of Appeal was filed with the United States Patent and Trademark Office on April 20, 2010.

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I. REAL PARTY IN INTEREST

Broadcom Corporation, a corporation organized under the laws of the state of California and having a place of business at 16215 Alton Parkway, Irvine California 92618-3616, has acquired the entire right, title, and interest in and to the invention, the application, and any and all patents to be obtained therefore, as set forth in the Assignment filed with the present application and recorded on 2/20/2002 at Reel/Frame 012614/0045.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences with this case.

III. STATUS OF THE CLAIMS

Claims 1-18 were cancelled.

Claims 19-21 were rejected under 35 U.S.C. § 103(a) as being obvious from Mair.

The rejection to claims 19-21 are appealed.

IV. STATUS OF AMENDMENTS

There are no amendments pending in the present application.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Features of the present invention may be found in a video encoding scheme supporting the transport of audio and auxiliary information.

Claim 19 is directed to a system for transmitting auxiliary data in video encoding. The system comprises an un-enhanced encoder, an enhanced encoder; an un-enhanced decoder, and an enhanced decoder. The un-enhanced decoder is adapted to communicate with said un-enhanced and enhanced encoders. The enhanced decoder is adapted to communicate with said un-enhanced and enhanced encoders.

Claim 19 is described in the specification for example a system for transmitting auxiliary data in video encoding comprising an un-enhanced encoder, an enhanced encoder; an un-enhanced decoder, and an enhanced decoder is described in the Specification, p. 4-8, Figure 1, (Un-Enhanced Encoder 101, Enhanced Encoder 111, Un-Enhanced Decoder 107, Enhanced Decoder 105). The un-enhanced decoder is adapted to communicate with said un-enhanced and enhanced encoders. Page 5, Lines 11-15; Figure 1, Un-Enhanced Decoder 107. The enhanced decoder is adapted to communicate with said un-enhanced and enhanced encoders. Page 5, Lines 11-15; Figure 1, Enhanced Decoder 105.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellant respectfully requests that the Board review the rejection of:

Claims 19-21 under 35 U.S.C. § 103(a) as obvious from Mair.

VII. CLAIM 19 IS NOT OBVIOUS FROM MAIR

Claim 19 was rejected under 35 U.S.C. § 103(a) as being obvious from Mair.

Claim 19 is reproduced below:

19. (Previously Presented) A system for transmitting auxiliary data in video encoding comprising:

an un-enhanced encoder;

an enhanced encoder;

an un-enhanced decoder adapted to communicate with said un-enhanced and enhanced encoders; and

an enhanced decoder adapted to communicate with said un-enhanced and enhanced encoders.

To reject claim 19, Examiner indicated that “As per claims 19-21, most of the limitations of these claims have been noted in the above rejection of claims 1, 12, and 13”, FOA at 5, and that “Mair discloses the same method of transmitting auxiliary data in video encoding (See Abstract) comprising receiving first and second data (See [0042], lines 4-6), encoding the first data based on a state of at least one bit of the second data (See [0033], lines 7-19 and [0035, lines 7-16), packaging the encoded first data and the second data into a single word (See [0042]), and communicating the single word (See [0043]).” FOA at 4.

Appellant notes that the present application claims a priority date to August 17, 2001 under 35 U.S.C. § 119(e)(1). The Appellant notes that Mair was filed on October 15, 2001 and claims priority to provisional application, Serial No. 60/296,924, filed June 8, 2001 (hereinafter, “the ‘924 Application”).

Although 35 U.S.C. 103(a) does not set forth what can be used as “prior art”, “[p]rior art available under 35 U.S.C. 102 is available under 35 U.S.C. 103.” MPEP 2141. While the rejection is made under 35 U.S.C. 103(a), it appears as though Examiner is claiming that Mair is prior art under 35 U.S.C. 102(e).

Reference is made to the following citation from the MPEP:

The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions **if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.**

See the M.P.E.P. § 2136.03 (Emphasis Added). Appellant points out that the ‘924 Application does not disclose any of the FIGS. 1-5, which were disclosed in Mair. In essence, the ‘924 Application merely summarizes the use of the 8 bit/10 bit encoding process, which is a part of the disclosure in Mair. The Applicant respectfully submits that **the ‘924 Application does not properly “support the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.”**

For example, with respect to independent claim 19, the Examiner relies on [0042], lines 4-6, [0033], lines 7-19, [0035], lines 7-16, [0042], and [0043]. See the Final Office Action at pages 3-4. As stated above, the ‘924 Application merely describes the use of the extra bits (Bit 8 and Bit 9) and it does not support any of the citations that the Examiner relies on (e.g., [0042], lines 4-6, [0033],

lines 7-19, [0035], lines 7-16, [0042], and [0043]), nor does it support any of the Figures 1-5 of Mair, corresponding to the above citations used in the Examiner's rejections.

For example, paragraph [0035] describes Figure 2, while [0042] and [0043] describe Figure 5. Neither Figures 2 or 5 are in the '924 application.

Examiner has indicated that:

The proposal submitted on the provisional application contains the elements to meet the 35 U.S.C. § 112 first criteria. The provisional application notes in the introduction that The DVI signal perform the encoding while two additional bits perform specific and distinct functions (See Introduction of the Provisional Application). The first and second functions of bits 8 and 9 in addition to the fact that DC balancing will be used to transport audio information are important in considering the proposal. The elements of the Abstract in the Application of Mair et al. (i.e., Publication No. 2002/0186322 A1) are proposed in the Introduction of the provisional. In addition, the Principle of Operation as well as in the section named "proposal" were considered by the examiner. Considering the fact that the elements of the abstract of Mair's Publication (2002/0186322 A1) are found in the proposal (which is the provisional application) it is clear to the examiner that one skilled in the art can and would look to the provisional application to derive the Abstract as well as to find the claimed limitations of the applicant.

FOA, at 2-3 (Emphasis Added).

Examiner's use of Mair as prior art, in view of the reasoning in the Final Office Action is erroneous because Examiner does not even allege, much less establish, that the '924 properly supports the subject matter (e.g., Mair [0042], lines 4-6, [0033], lines 7-19, [0035], lines 7-16, [0042], and [0043]) relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph. The fact

that “the elements of the abstract of Mair’s Publication (2002/0186322 A1) are found in the proposal (which is the provisional application)” is simply not the proper standard for determining whether the “critical reference date of” Mair “is the filing date of the provisional application”.

Therefore, since the ‘924 Application does not properly support the subject matter relied upon to make the rejection, the 35 U.S.C. 102(e) critical date of Mair should not be the filing date of the ‘924 Application, but rather the filing date of the utility application, which is October 15, 2001. Since the present application has a priority date August 17, 2001, Mair is not prior art under 35 U.S.C. 102(e).

For the foregoing reasons, Appellant respectfully requests that the Board REVERSE the rejection to claim 19 and dependent claims 20 and 21.

VIII. CONCLUSION

For the foregoing reasons, all of the pending claims are distinguishable over the prior art of record. Reversal of the Examiner's rejection and issuance of a patent on the application are therefore requested.

The Commissioner is hereby authorized to charge \$500 for the Appeal Brief fee and any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,



Mirut P. Dalal
Registration No. 44,052
Attorney for Appellant

Dated: September 20, 2010

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, IL 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100

CLAIMS APPENDIX

1-18. (Cancelled)

19. (Previously Presented) A system for transmitting auxiliary data in video encoding comprising:

an un-enhanced encoder;

an enhanced encoder;

an un-enhanced decoder adapted to communicate with said un-enhanced and enhanced encoders; and

an enhanced decoder adapted to communicate with said un-enhanced and enhanced encoders.

20. (Previously Presented) The system of Claim 19, wherein said enhanced decoder is adapted to communicate enhanced data word.

21. (Previously Presented) The system of Claim 19, wherein said un-enhanced encoder is adapted to communicate un-enhanced data word.

EVIDENCE APPENDIX

(None)

RELATED PROCEEDINGS APPENDIX

(None).